

### **REMARKS/ARGUMENTS**

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

#### ***Claim Rejections – 35 USC § 103***

At page 3 of the Office Action, the Examiner rejects claims 1 to 14 as being unpatentable over "Intelligent Paper" by M. Dymetman and Max Copperman (herein referred to as 'Intelligent Paper').

Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Claims 1 and 8 have been amended to include the computer system printing the publication using a printer, wherein said printer prints both the human-readable information and machine- readable coded data. Support for these features can be found at page 20, lines 8 to 10 where the specification states that the printer simultaneously prints various forms of visible ink, used for printing the human-readable information, and infrared ink, used for printing the machine-readable coded data.

In regard of amended claims 1 and 8, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

*"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."*

"Intelligent Paper" describes a process involving two separate entities, the supplier and the publisher, printing the invisible data and visible information respectively. At the first paragraph of page 394, "Intelligent Paper" clearly states that the process includes an

authorised producer for producing the sheets of paper which include encoded data. A publisher then uses the apparently blank sheets to print information with conventional visible inks. Thus, the first printer used by the producer only prints encoded data and fails to print the visible information, and the second printer used by the publisher prints the visible information but fails to print the encoded data.

This is in total contrast to amended claims 1 and 8 which specify that said printer prints both the human-readable information and the machine-readable coded data.

Amended claims 1 and 8 provide a number of solutions to problems that exist with the process described by "Intelligent Paper".

Such problems associated with the process described by "Intelligent Paper" include when the publisher wishes to print the visible information representing the digital page on the encoded page, the publisher will need to sense the encoded data on the page such as to associate the digital page with the visible information. Furthermore, if various portions of the visible information need to be associated with individual locations on the encoded page, the coded data for each location will be required to be sensed to record an association between the locations on the page and locations on the digital page.

Additionally, two separate printers are required by the process described by "Intelligent Paper" which can be costly.

Moreover, as the process described by "Intelligent Paper" uses pre-encoded pages, the process suffers from inaccuracy. If the visible information is printed onto the pre-encoded page whilst the page is skewed during printing, the location of the visible information will not correspond to the correct coded data. For example, the sensing device may be placed on Intelligent Paper in relation to visible information representing England on a map of the world, but the coded data which is sensed may actually correspond to France due to the skewing problem.

The method and system provided by claims 1 and 8 respectively can ameliorate these problems.

By having the same printer print the coded data and the visual information, an association between the coded data and the visual information can be recorded whilst printing, thus eliminating the step of having to sense the coded data on the page prior to printing the visual information on a different printer.

Furthermore, as only one printer is used to print both the coded data and the visual information, the cost of the process is significantly cheaper.

Additionally, accuracy of printing the coded data and the visual information is increased due to a reduction in skewing. Thus, the association between the coded data and the visual information is far more accurate as the same printer prints both the coded data and the visual information.

Thus, the first basic requirement for a prima facie case of obviousness cannot be satisfied for amended claims 1 and 8 in regard of the reference "Intelligent Paper".

In particular, "Intelligent Paper" fails to disclose a method or system including a computer system which prints machine-readable coded data and human-readable information using one printer. "Intelligent Paper" actually teaches the very opposite in that two separate printers should be used to print the coded data and the information using different printers. Furthermore, we highlight to the Examiner MPEP §2141.02 *"Prior art must be considered in its entirety, including disclosures that teach away from the claims"* which states:

*"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) "* (emphasis added to bold section of MPEP)

"Intelligent Paper" leads away from the claimed invention by teaching that two separate printers should be used to print the coded data and the visible information. Thus, a person of ordinary skill in the art would be lead to believe that this is required as nothing in the document teaches otherwise.

Therefore, a person of ordinary skill in the art would not be motivated modify the process and system taught by "Intelligent Paper" such that a single printer in used to print both the

coded data and the visible information. Hence, the first basic requirement of a prima facie case of obviousness cannot be satisfied by the reference "Intelligent Paper".

Furthermore, the second basic requirement for a prima facie case of obviousness cannot be satisfied for amended claims 1 and 8 in regard of "Intelligent Paper". In particular, "Intelligent Paper" fails to provide any reasonable expectation of success to print the coded data and visible information using the one printer.

Additionally, the third basic requirement for a prima facie case of obviousness cannot be satisfied for amended claims 1 and 8 in regard of "Intelligent Paper". In particular, "Intelligent Paper" fails to disclose all the claim limitations of claims 1 and 8 which include a printer which prints both the coded data and the visual information.

In light of "Intelligent Paper" failing to satisfy the first, second, and third basic requirements for a prima facie case of obviousness, as stated at MPEP §2143, we respectfully request reconsideration and withdrawal of this rejection. Moreover, since "Intelligent Paper" includes portions that would lead away from the claimed method and system, the prima facie case of obviousness should be withdrawn, as stated at MPEP §2141.02.

If the Examiner wishes to maintain the obviousness rejection in light of "Intelligent Paper", we would appreciate the Examiner satisfy each and every one of the three basic requirements of a prima facie case of obviousness. Furthermore, we would appreciate if the Examiner would explain how a prima facie case of obviousness rejection can be maintained when portions of the "Intelligent Paper" lead away from the claimed method and system.

**CONCLUSION**

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

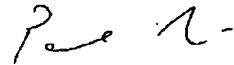
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